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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Story et al.
Title: LICENSE MANAGEMENT FOR DIGITAL CONTENT
Application No.: 09/222,336
Filed: December 28, 1998
Group Art Unit: 3622
Confirmation No.: 3308
Examiner: Yehdega Retta

ORAL ARGUMENT REQUESTED

REPLY BRIEF

Dear Sir:

Applicants (hereafter "appellant") hereby submit this Reply Brief in triplicate in support of its appeal in accordance with the decision of the Pre-Appeal Review Panel. This Reply Brief is filed in response to the Examiner's Answer mailed October 16, 2007. Appellant respectfully requests consideration of this Reply Brief by the Board of Patent Appeals and Interferences for allowance of the present patent application.

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I. STATUS OF THE CLAIMS

Claims 1-8, 10-18 and 20-36 are pending in the present application. Claims 9 and 19 have been canceled during prosecution. Claims 31-36 were added during prosecution. Claims 1-8, 10-18 and 20-36 were rejected in the Office Action mailed August 11, 2005 and are the subject of this appeal brief. Claims 34-36 are canceled herein to put the case in a better condition for appeal.

Claims 1-8, 10-18 and 20-36 stand rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-8, 10-18 and 20-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,926,624 issued to Katz, et al. (hereinafter "Katz").

ORAL ARGUMENT REQUESTED

Pursuant to 37 C.F.R. § 41.47, appellant hereby requests oral argument. A separate paper requesting oral argument (PTO/SB/32) in compliance with 37 C.F.R. § 41.47(b) is transmitted herewith.

II. GROUND OF REJECTION TO BE REVIEWED

1. Whether the subject matter of claims 1-8, 10-18 and 20-36 is described in appellant's specification such that it reasonably conveys to one of ordinary skill in the art that the inventors had possession of the claimed invention at the time the application was filed.

2. Whether claims 1-8, 10-18 and 20-36 are anticipated by Katz.

III. ARGUMENT

A. THE REJECTION OF CLAIMS 1-8, 10-18 and 20-36
UNDER 35 U.S.C. § 112, FIRST PARAGRAPH SHOULD BE
REVERSED BECAUSE THE SPECIFICATION CLEARLY
DESCRIBES A LICENSE COMPRISING A CARDINALITY

Claims 1-8, 10-18 and 20-36 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as to convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Central to this appeal is the issue of whether appellant's specification supports the claim feature of a "license comprising a cardinality." Appellant respectfully submits that a plain and straightforward reading of the specification shows that this feature is indeed fully supported by an enabling written description and does not constitute new matter.

In short, appellant's specification teaches the following: 1) a user may request a license that allows the playback of digital content on his or her playback device; 2) the user may specify the cardinality of the license when making the license request; 3) a license management device creates a license having the specified cardinality; 4) the

license is transmitted to the user for installation on certain of the user's playback device(s); and 5) the number of playback devices which can store the license is restricted by the cardinality component of the license.

Support for these features can be found in numerous places in specification, including at page 11, line 10 to page 15, line 8 and in FIGS. 5 and 6. Nevertheless, in an attempt to focus on the issue at hand, appellant points to three specific sections of the specification. Namely, page 11, lines 10-11, page 14, lines 6-8 and page 14, lines 11-13, respectively, which explain that:

In operation, license management device 510 creates a license having a cardinality in response to a request.

A license is requested at 610. In one embodiment, a user of a playback device accesses a license management device and requests a license having a specific cardinality.

The license management device creates a license at 620. The license has a cardinality that determines the number of playback devices in which the license can be stored.

From these and the other sections cited above, appellant's specification clearly explains that the license itself contains a cardinality component. The subject of

each of these excerpts is the license, which is described as being created by the license management device and is modified to include the cardinality component requested by the user. Consequently, a plain and straightforward reading of the specification shows that ample written description exists in multiple places for the "license comprising a cardinality" feature and thus does not constitute new matter.

Further support for appellant's position may be found at pages 13, lines 3-8 and 15-16, respectively, which explain that:

In the following example, it is assumed that a household of four individuals (Husband, Wife, Son and Daughter) has four playback devices; one for each individual. Each member of the household may wish to have access to the "New York Times." The household obtains a license with a cardinality of four to store in each of the playback devices. The playback devices are then authorized to play digital versions of the "New York Times" that include the license that is also stored in the playback devices. (emphasis added)

Husband and Son may wish to have access to "Sports Illustrated." The household obtains a license with a cardinality of two.

Similar to the three sections of specification cited above, each of these other sections also clearly explain

that the user, in this case the household, obtains a license with a specified cardinality. Again, it is the license itself which is requested and created with the requisite cardinality, and subsequently delivered to the user. Accordingly, appellant's specification provides clear and ample written description for the "license comprising a cardinality" feature at issue in this appeal. No new matter has been added.

Reply To Examiner's Response

A central theme of the Answer relates to the Examiner's belief that the license disclosed in appellant's specification is somehow limited to a specific data structure described in the specification which is used to identify groups of users (*i.e.*, a 32 bit group identifier). In particular, the Examiner states on page 7 of the Answer that:

"In light of the specification as best understood by the Examiner, the playback devices that include this ID indicate the cardinality: number of playback devices that are authorized. If the license (32 bit Group ID) includes or comprises of [sic] cardinality, then which part of the 32 [sic] group ID is considered cardinality? In short, for the license to consist of cardinality, the specification does not teach which part of the 32 bit Group ID provides an indication of how many devices are authorized, since the cardinality is associated with [sic] number."

This reasoning illustrates several misunderstandings held by the Examiner that form the basis of the current rejection, namely that: 1) the 32 bit group ID relates to the cardinality, and that 2) the disclosed license is limited to the 32 bit group ID. Initially, it is constructive to consider the portion of appellant's specification that is concerned with the 32 bit group ID. Page 12, lines 16-19 explains that:

In one embodiment, the license comprises a 32 bit group identifier; however, other identifier sizes can also be used. Thus, each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that includes the license.

As can be seen from the plain language of this specification excerpt, the 32 bit group ID merely identifies a group (e.g., a set) of one or more playback devices that store a particular license (as the plain meaning of its name implies). The 32 bit group ID is not concerned with providing cardinality information. No portion of the specification teaches otherwise nor does the Examiner provide any explanation of how or why a correlation has been drawn between the 32 bit group ID and the cardinality component of appellants' disclosed license.

Accordingly, the Examiner's assumption that the 32 bit group ID provides cardinality information is incorrect, and thus any limitations associated with that assumption that form the basis of the current rejection are also incorrect.

Further, appellant's specification clearly explains that the license comprises a 32 bit group ID. It is a well accepted principle of U.S. patent law that word "comprises" is to be interpreted as open ended and non-limiting. When this proper meaning is applied to appellant's specification, it is clear the specification teaches that the disclosed license may include, but is not limited to, a 32 bit group ID.

The Examiner, on the other hand, impermissibly attempts to limit the license to include only the 32 bit group ID ("which part of the 32 [sic] group ID is considered "cardinality"?). Nowhere in the specification does appellant limit the disclosed license to only include the 32 bit group ID. In fact, by choosing the word "comprising" to modify license in this section of the specification, appellant made a deliberate and conscious decision not to limit the content of the license to this specific data structure. Accordingly, the Examiner's

attempt to limit the disclosed license to include only a 32 bit group ID is clearly improper and incorrect.

Once the notion that appellant's license is limited to a 32 bit group ID is dispelled, it becomes clear that, in one embodiment, the license disclosed by appellant's specification includes an authorization component (see, for example, appellant's specification, page 12, lines 3-7) a cardinality component (see, for example, appellant's specification, page 10, lines 10-11, page 14, lines 6-8 and page 14, lines 11-13) and a group ID component (see, for example, appellant's specification, page 7, lines 16-19).

Moreover, appellant notes that digital licenses and their construction were very well known at the time this application was filed. Also very well known at the filing date of this application was how to digitally represent a number (such as a cardinality parameter). Appellant need not provide the specific low level implementation details of such well known technologies in its specification to fulfill the written description requirement. See, for example, *Hyatt v. Boone* 47 USPQ2d 1128 (Fed. Cir. 1998) "This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of

ordinary skill in the art and yet unfamiliar to the laymen need not be set forth."

Furthermore, in appellant's original Appeal brief, it was explained to the Examiner that the specification does indeed provide specific written description support for the "license comprising a cardinality" feature. In fact, it was explained that this written description support was virtually word for word. See Appeal brief, page 7. However, rather than explaining why this word for word description is considered insufficient, the Examiner instead completely ignores this position and makes no response to this argument whatsoever (other than pointing to the 32 bit group ID as somehow superseding the plain language meaning of the majority of the specification).

Thus, appellant reiterates that the specification, at page 11, lines 10-11, (among others) explains that "In operation, license management device 510 creates a license having a cardinality." This portion of the specification constitutes word for word support for the claim feature alleged to be "new," with the exception of the use of the non-limiting inclusive word "having," which clearly provides support for the open ended transitional phrase "comprising" as set forth in the pending claims.

Accordingly, appellant respectfully submits the specification provides and clear and ample written description for the claim feature "license comprising a cardinality" at issue in this appeal. No new matter has been added. Thus, the rejection pursuant to 35 U.S.C. § 112, first paragraph, should be reversed.

B. REJECTION OF CLAIMS 1-8, 10-18 and 20-36 UNDER 35 U.S.C. § 102(e) AS BEING ANTICIPATED BY U.S. PATENT NO. 5,926,624 IS IMPROPER BECAUSE THE REFERENCE IS NOT OFFERED TO SHOW A LICENSE COMPRISING A CARDINALITY

Claims 1-8, 10-18 and 20-36 stand rejected under 35 U.S.C. § 102(e), as clearly being anticipated by Katz.

As explained by the Examiner on page 8 of the Answer, this rejection is based on the assumption that: 1) appellant's license is limited to a 32 bit group ID, and that: 2) the claims at issue should be interpreted as "having a cardinality associated with the license" despite the fact that the words specify "a license comprising a cardinality."

However, appellant has demonstrated above that both of these assumptions by the Examiner are incorrect. As a result, the Examiner's rejection with respect to Katz collapses. In particular, it has been clearly

demonstrated above that the license is not, and should not, be limited to merely a 32 bit group ID, but rather as having a license component and a cardinality component. Further, the claims at issue in this appeal specify "a license comprising a cardinality" and should be given their plain and ordinary meaning rather than the alternate meaning offered by the Examiner of "having a cardinality associated with the license" which is not reflected by the actual words in the claim.

As a result, because the claims at issue in this appeal specify "a license comprising a cardinality" and should be given their plain and ordinary meaning, the rejection based on Katz must fail, because Katz is not offered by the Examiner to show "a license comprising a cardinality."

Nonetheless, appellant presents discussion below explaining why the pending claims, as presented or properly interpreted (e.g., a license comprising a cardinality) are allowable over Katz. Although the Examiner found these arguments persuasive in the past, appellant reiterates them here for convenience.

Katz discloses a digital library and a mobile playback device that can be used to play digital content

from the digital library. See, for example, Fig. 2. Katz discloses that playback devices can be members of one or more groups and include a group ID. See Katz, col. 12, lines 39-67. However, the group ID of Katz is merely a number that identifies a group. The group ID does not indicate a number of playback devices in the group nor does it provide any restriction on the content a particular device may play. Thus, Katz fails to show or suggest a license comprising a cardinality as specified in appellant's pending claims.

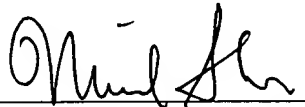
For at least the foregoing reasons, appellant submits that pending claims, including claims 1-8, 10-18 and 20-33 are not anticipated by Katz. Appellant therefore requests that the rejection of these claims under 35 U.S.C. § 103(a) be reversed.

IV. CONCLUSION

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

Date: 12/12/07

Respectfully submitted,



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